

REMARKS

I. Status of Claims

Prior to entry of this paper, **Claims 12-18** were pending. **Claims 12-18** were rejected. In this paper, **Claim 12** is amended. **Claims 12-18** are currently pending. No new matter is added by way of this amendment. For at least the following reasons, it is respectfully submitted that each of the presently pending claims is in condition for allowance.

III. Request to Reconsider and Withdraw Finality

The following factual observations are made with regard to this application:

A Final Rejection was issued on June 5, 2007, rejecting claims 12-18. An amendment after final was submitted on August 6, 2007, comprising an amendment to Claim 12. On August 14, 2007, an advisory action was issued without entering this amendment after final, stating, "They raise new issues that would require further consideration and/or search". On September 5, 2007, a Request for Continued Examination was filed, requesting that the amendment after final be entered and considered. On November 28, 2007, the most recent Office Action was issued, noting on the Office Action Summary that "This action is FINAL". PAIR also indicates that this Office Action was counted as a "Final Rejection".

However, it is respectfully submitted that, in light of the above noted sequence of events, such finality is premature and is not proper. MPEP 706.07(b) specifically states:

However, it would not be proper to make final a first Office action in a continuing or substitute application or an RCE where that application contains material which was presented in the earlier application after final rejection or closing of prosecution but was denied entry because (A) new issues were raised that required further consideration and/or search, or (B) the issue of new matter was raised.

Accordingly, since the amendments of August 6, 2007 were denied entry because of required "further consideration and/or search", it is not proper to make final the first Office Action

in an RCE that involves entry of these amendments. The Office Action issued November 28, 2007, is a first such Office action after RCE. In light of at least the above cited passage of the MPEP, it is respectfully requested that the finality indicated in this most recent Office Action be withdrawn.

III. Claim Rejections - 35 U.S.C. § 103

Claims 12, 13 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gai et al., U.S. Patent No. 6,697,360 (hereafter "Gai-Cisco"), in view of Oran et al., U.S. Patent No. 6,204,084 (hereafter "Oran-Cisco").

With this paper, Claim 12 has been amended to further clarify the difference, and thus patentability, between the claimed invention and the previously applied prior art. Specifically, the nature of the broadcast frame has been clarified to be that of a 'force request'. Support for this amendment can be found throughout the application, as originally filed, and particularly on page 5, lines 1-5 of the specification which indicates that a forced IP address is issued as part of a "force request".

Claim 12, as amended, for example, at least recites the limitation of:

broadcasting a broadcast frame from the management node as a force request including the unused IP address to the direct internet protocol module without reconfiguring the management node, wherein the IP address of the network element is changed to the unused IP address

After carefully reviewing the applied teachings – particularly those of Gai-Cisco, it is respectfully submitted that the claimed invention, as represented in amended Claim 12, is not taught or suggested by either of the previously applied prior art references.

The teachings of Gai-Cisco specifically center on the ability of an intermediate device, as an extension of the DHCP protocol, to request and receive IP addresses for association with the intermediate device (col. 5, lines 34-40). Alternately stated, the intermediate device, the device to which an IP address is given, is the same device that first requests the IP address. Such an arrangement is verified in the more detailed teachings of Gai-Cisco. For example, the DHCPDISCOVER message from an intermediate device of a switch 214, is set to "request", as part

of the initial step of acquiring a stable IP address (col. 8, lines 18-34). The response to this initial DHCPDISCOVER message from a server, such a 220 or 222, is not indicated as a request, but rather a “reply” as part of a DHCPOFFER message (col. 9, lines 21-23 and 28-36). The switch 214 then proceeds to select at least one of the received IP addresses that it initially requested (col. 10, lines 19-22). This pattern of a switch request, followed by a server reply, is repeated throughout the communication arrangement of Gai-Cisco (see, for example, switch requests in col. 11, lines 26-30 and col. 13, lines 16-33).

However, an “offer” or something “proffered” is not the same as a request, nor is it a representation of force. Such a difference is even recognized in the language of Gai-Cisco cited above. In fact, the messaging noted in Gai-Cisco to be initiated from a server, such as 220, does not contain an unused IP address, but rather, is simply a ROUTER RECONFIG message. This message, even in such circumstances, still results in the switch – not the server – initiating the actual request for configuring a new connection (col. 16, lines 34-42). Again, the end user of the IP address, the switch, is the source of requests in Gai-Cisco, not the server. With regard to the reply on page 2 of the most recent Office Action, it is respectfully submitted that the teachings of Gai-Cisco are so limited by the collective teachings discussed above.

In contrast, in the claimed invention, as represented in amended Claim 12, clearly recites that the unused IP address is issued as part of a force request from a management node, at least by way of the limitation “broadcasting a broadcast frame from the management node as a force request including the unused IP address”. The nature of the unused IP address, received and used by a second device (i.e., the “network element”), is further represented in the claim at least by the limitations “from the management node” and “wherein the IP address of the network element is changed to the unused IP address”. As further detailed above, this relationship is different than that expressed in the DHCP-based relationship of the server and switch in Gai-Cisco, noting that the “server” of Gai-Cisco appears to have been equated in the most recent Office Action to the claimed “management node”, while the “switch” appears to have been equated to the claimed “network element”. It is respectfully submitted that such a difference underscores at least one distinction, and thus grounds for patentability, between the applied “server” and “switch” of Gai-Cisco and the “management node” and the “network element” as further claimed in at least Claim 12.

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Claims 15 and 16 were rejected under 35 U.S.C. 103(a) as being unpatentable over Gai and Oran in view of Fuoco et al., U.S. Patent No. 6,594,713 (hereafter "Fuoco-Texas").

However, so far as Claims 15 and 16 depend directly or indirectly from Claim 12, it is respectfully submitted that these claims incorporate the above noted limitation of Claim 12, and are not taught or suggested by the combination of Gai-Cisco and Oran-Cisco for at least the same reasons. It is respectfully submitted that the external port interface related teachings of Fuoco-Texas, mentioned for example in col. 8, lines 33-39 do not cure the deficiencies of Gai-Cisco and Oran-Cisco presented herein. Accordingly, withdrawal of these rejections under 35 U.S.C. §103(a) is also respectfully requested.

With particular regard to Claim 16, it is also respectfully submitted that the notions of "disabled" and "time after power up", as further claimed in Claim 16, are not taught or suggested by Fuoco-Texas. The Office Action, at page 8, section 17, explicitly states that Gai-Cisco and Oran-Cisco do not teach such limitations. Not "forced", as suggested by Gai-Cisco in column 9, and "disabled" as claimed in Claim 16, are clearly different concepts, at least so far as they pertain to different ends of a communication system. Fuoco, however, in the cited figures of 1, 3, and 10, and the passage cited of Figure 8 does not mention these concepts either.

In fact, it is respectfully submitted that amending such a feature as claimed in Claim 16 to the teachings of Gai-Cisco would render the system of Gai-Cisco inoperable for its intended purpose. Namely, the ability to automatically modify subnets would be expressly inhibited by such an added feature, since the ability to reconfigure would be disabled after the claimed "predetermined amount of time after power up" of Claim 16 (see col. 16, lines 28-42 of Gai-Cisco). Again, the concept of "predetermined time after power up", as further claimed in Claim 16, is not mentioned, much less suggested by the cited teachings of Gai-Cisco, Oran-Cisco, and Fuoco-Texas.

On these additional grounds of failure to at least suggest the limitations of Claim 16, as well as the incompatibility of any such combination, it is respectfully requested that the rejection of Claim 16 be withdrawn as well.

IV. Conclusion

In view of the above amendment, applicant's representative believes the pending application is in condition for allowance.

Dated: January 28, 2008

Respectfully submitted,

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